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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/531,307

04/13/2005

Kenji Suzuki

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22850

7590

11/28/2008

OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C.

1940 DUKE STREET

ALEXANDRIA, VA 22314

EXAMINER

MULLIS, JEFFREY C

ART UNIT

PAPER NUMBER

1796

NOTIFICATION DATE

DELIVERY MODE

11/28/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/531,307	<b>Applicant(s)</b> SUZUKI ET AL.	
	<b>Examiner</b> Jeffrey C. Mullis	<b>Art Unit</b> 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-7 is/are rejected.
- 7) ☒ Claim(s) 8 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 3-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi et al. (US 6,414,059).

Patentees disclose a composition containing up to 55% block copolymer, 0-40% softener and 5-80% acrylate rubber. Note the paragraph bridging columns 4 and 5. The aromatic block may be formed from vinyl toluene at column 9, lines 40-45. Note that the ingredients a-f are "micro-disperse(d)" and would thus encompass "island(s)" while the remainder of the composition would encompass a "sea" phase as the remaining components would be the continuous, not micro dispersed phase. Since the composition of the patent and instant claims are similar, similar characteristics are assumed inherent.

There are no examples in the patent of compositions having the specific combination of limitations of applicants although such falls within the broad ambit of the patent. Hence to choose applicants combination of materials from the patent would have been obvious to a practitioner having an ordinary skill in the art at the time of the invention in the expectation of adequate results, absent any showing of surprising or unexpected results.

Claim 8 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicant's arguments filed 9-29-08 have been fully considered but they are not persuasive. The examiner admits that there is no example of compositions in Kobayashi containing all of applicants limitations in combination. However it is not the position of the examiner that Kobayashi anticipate the rejected claims. All of applicants components are disclosed by the reference examiner useable in the composition of the reference. With regard to applicants characteristic, the prior art relied upon uses large amounts of inorganics and hence it would be expected by those skilled in the art that high abrasion resistance would be inherent in any composition produced when operating within the confines of the reference. Applicants point to applicants specification data, but as the examiner has pointed out before no inorganics are present and the data is therefore not an embodiment of the reference. Applicants argument in response is that results with filled compositions would be "irrelevant" to unexpected results. However unexpected results must be with closest prior art as required by MPEP 716 and therefore failure to provide data according to the reference cannot be said to be irrelevant. Such data cannot be said to provide "unexpected results" within the meaning of the guidelines of MPEP 716. The examiner is aware that it has been held that data closer to the claims than the prior art may be presented but exclusion of a feature encompassed by the claims which recite open language does not make applicants data closer to the claims than the prior art. Assuming that the examiner is incorrect about this however,

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applicants' data is still not probative of patentability since the acrylic resin of applicants data is not taught by the reference at all either alone or in combination with other materials nor are the rejected claims limited to such acrylates and for this reason also the data is not an embodiment of the prior art and furthermore rely on limitations not present in the claims. It is noted that claim 8 which does require acrylates not taught by the reference is now allowable since no prima facie case of obviousness can be made over the prior art.

Any inquiry concerning this communication should be directed to Jeffrey C. Mullis at telephone number 571 272 1075, M-F, 9-5pm.

JCM

11-23-08

Jeffrey C. Mullis  
Primary Examiner  
Art Unit 1796

/Jeffrey C. Mullis/

Primary Examiner, Art Unit 1796